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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,720	07/24/2001	James P. Hearn	8932-177	1799

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JONES DAY  
222 EAST 41ST STREET  
NEW YORK, NY 10017-6702

EXAMINER
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RAMANA, ANURADHA

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/910,720

Applicant(s)

HEARN ET AL.

Examiner

Anu Ramana

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 4/21/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 5-16, 27, 29-39, 41, 43-46, 49-54, 64, 65, 67, 72, 73, 76, 78-85 and 87 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 5-16, 45-46, 49, 67, 72-73, 76 and 78-85 is/are allowed.
- 6) ☒ Claim(s) 1, 27, 29, 31-39, 41, 43-44, 64, 65 and 87 is/are rejected.
- 7) ☒ Claim(s) 30 and 50-54 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 24, 2006 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 27, 29, 31-36, 39, 41, 43 and 87 are rejected under 35 U.S.C. 102(b) as being anticipated by Lerch (US 5,800,436).

Lerch discloses a clamp having a first clamping member 21 with a substantially or “almost entirely” smooth concave inner surface, a second clamping member 22 with a substantially or “almost entirely” smooth concave inner surface and a shaft or “tube” or “integral extension member” 112 received in bore 211 of first clamping member 21; the extension member 112 having a head 111 to prevent the first clamping member 21 from sliding off the extension member (col. 1, lines 42-51, col. 2, lines 50-64 and Figure 1).

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Lerch further discloses a notch or "stop" or "proximal flared portion" or "crimp" 112c (col. 3, lines 34-43).

Regarding claim 35, Lerch discloses that shaft 112 is trimmed off with a tool of the type employed to fasten blind rivets. Thus, shaft 112 is deformed to plug opening 221 in second clamping member 22 in the manner of a countersink, i.e., the trimmed shaft is flush with the upper surface of the second clamping member.

Regarding claim 87, the method by which an apparatus is made, "provided by mechanical deformation of the extension member" is not given any patentable weight in an apparatus claim (*In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972)).

Claims 1 and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Herrington et al. (US 6,379,363).

Herrington et al. disclose a cranial clamp having a smooth base or first clamping member 12, a head 30 disposed proximate first clamping member with a bore, a stem or "integral extension member" or "tube" 16 placed in the bore of head 30, a smooth cap or second clamping member 14 and an "integrally formed stop member" or "crimp" or "ridge" or "twisted portion" or "proximal flared portion" 34 which limits the movement of clamping member 14 on extension member 16 (Figures 1 and 21e, col. 4, lines 4-67 and col. 5, lines 5-31).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35, 37-38 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lerch (US 5,800,436).

Regarding claims 37 and 38, although Lerch does not disclose that extension member 16 is a ribbon or a longitudinal member with a rectangular cross section, it would have been obvious to one of ordinary skill in the art to substitute a ribbon for the extension member wherein so doing would amount to mere substitution of one functionally equivalent structure for another within the same art, namely a structure capable of being sheared off against a suitable surface, and the selection of any of these structures would work equally well in the claimed device.

Regarding claim 44, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a fastener hole in second clamping member for securing the clamping member since it is well known in the art to utilize fasteners for the purpose of securing one member to another.

Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herrington et al. (US 6,379,363).

Herrington et al. disclose all elements of the claimed invention except for a fastener hole in the second clamping member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a fastener hole in second clamping member for securing the clamping member since it is well known in the art to utilize fasteners for the purpose of securing one member to another.

### ***Response to Arguments***

Applicant's arguments submitted under "REMARKS" in the response filed on have been considered but are moot in view of the new ground(s) of rejection.

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***Allowable Subject Matter***

Claims 30 and 50-54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 2, 5-16, 45-46, 49, 67, 72-73, 76 and 78-85 are allowed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR

*Anuradha Ramana*

July 7, 2006